

REMARKS

Claims 1, 11, 14, 17 and 28 have been amended to more clearly describe Applicants' invention. New claims 35, 36 and 37 have been added. Claims 11 and 14 have been amended to correct clerical errors. Support for the amendments and new claims can be found throughout the specification, for example, in Figures 1-18. No new matter has been added. Claims 1-37 are pending.

Rejections under 35 U.S.C. § 102

Panescu

Claims 1, 2, 3, 7, 9, 11, 14, 17, 19, 20-22, 24-25 and 31 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,688,267 to Panescu *et al.* ("Panescu"). See pages 2-3 of the Office Action. Claims 1, 11, 14 and 17 are independent.

The Examiner has included claim 31 as a rejected claim. However, claim 31 depends from independent claim 28, which was not rejected. Applicant believes the inclusion of claim 31 in this rejection was an oversight.

With respect to independent claims 1, 11, 14 and 17, Applicant has discovered a device or system for ablating tissue that includes an elongate member defining a longitudinal passage or lumen having a distal opening and a proximal opening dimensioned to pass or slide over a guide element directed into the tissue.

The Examiner contends that Panescu discloses "an elongate/tubular member (figure 15; element 22) with longitudinal passage/lumen dimensioned to pass a guide element (126)." See page 2 of the Office Action. However, Panescu discloses a system and method for ablating heart tissue in which element 126 moves a temperature element 110 within catheter body 22. See column 19, line 15 - column 20, line 17 of Panescu. Element 126 of Panescu stops within catheter body 22. As such, element 126 is not a guide element directed into tissue and the catheter body 22 is not dimensioned to pass or slide along and over the element 126. Panescu does not describe a device or system for ablating tissue that includes an elongate member defining a longitudinal passage or lumen having a distal opening and a proximal opening dimensioned to pass or slide over a guide element directed into the tissue.

Accordingly, independent claims 1, 11, 14 and 17, and claims that depend therefrom are not anticipated by Panescu. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Brucker

Claims 1-20, 22-23, 25-30 and 33-34 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,500,012 to Brucker *et al.* ("Brucker"). See pages 3-5 of the Office Action. Claims 1, 11, 14, 17 and 28 are independent.

Applicant has discovered a device or system for ablating tissue that includes an elongate member defining a longitudinal passage or lumen having a distal opening and a proximal opening dimensioned to pass or slide over a guide element directed into the tissue. See independent claims 1, 11, 14 and 17.

According to the Examiner, Brucker discloses "an elongate/tubular member (figure 1; element 16) with longitudinal passage/lumen (17) dimensioned to pass a guide element (68; col. 5:47-49)." See page 3 of the Office Action. However, the cited passage at column 5, lines 47-49 of Brucker states "[t]he outer diameter of the laser catheter plastic tubing sheath 68 is such that it will fit down the *internal* lumen 17 of the mapping/guiding catheter 10 of Fig. 1." In Brucker, passage 17 is not dimensioned to pass or slide over element 68. Thus, Brucker does not disclose device or system for ablating tissue that includes an elongate member defining a longitudinal passage or lumen having a distal opening and a proximal opening dimensioned to pass or slide over a guide element. Thus, independent claims 1, 11, 14 and 17 are not anticipated by Brucker.

Applicant has also discovered a method for thermal ablation of a target volume including perforating and penetrating a living body using a guide element to establish a tract through the body to the target volume and sliding an electrode along and over the guide element directed into the body to position the electrode near the target volume. See independent claim 28.

The Examiner contends that Brucker discloses "[m]ethod steps include using a guide element (30) to establish a tract; (using embodiment in figure 12) sliding an electrode (202, 204) including an elongate member (200) along the guide element (col. 7:16-18; ablation catheter in figure 6 is directly analogous to that in figure 12)." See page 4 of the Office Action. Brucker does not describe perforating and penetrating a living body using a guide element to establish a tract through the body to the target volume and sliding an electrode along and over the guide

element directed into the body to position the electrode near the target volume. In Brucker, an RF catheter is passed through lumen 17. See column 7, lines 37-40 and Figure 10 of Brucker. The RF catheter in Brucker does not slide along and over a guide element. In addition, the embodiment referred to by the Examiner in Figure 12 features liquid ablation chemicals (col. 10, line 8), not an electrode. Thus, independent claim 28 is not anticipated by Brucker.

Accordingly, independent claims 1, 11, 14, 17 and 28, and claims that depend therefrom are not anticipated by Brucker. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Rejections under 35 U.S.C. § 103

Brucker in view of Panescu

Claims 21, 24 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brucker in view of Panescu. See page 5 3 of the Office Action. Claims 21 and 24 depend from independent claim 17. Claim 31 depends from independent claim 28.

The Examiner contends that "Panescu discloses an anchor as discussed above that could easily and obviously be inserted into the Brucker device submitted above. The motivation to do so is to anchor the device to the targeted tissue to prevent slippage during energy application." See page 5 of the Office Action.

Applicant respectfully disagrees. Neither Brucker nor Pansescu describe or suggest a device or system for ablating tissue that includes an elongate member defining a longitudinal passage having a distal opening and a proximal opening dimensioned to slide over a guide element directed into the tissue (independent claim 17) or a method for thermal ablation of a target volume including perforating and penetrating a living body using a guide element to establish a tract through the body to the target volume and sliding an electrode along and over the guide element directed into the body to position the electrode near the target volume (independent claim 28). There is no teaching or suggestion in Brucker, Panescu, or a combination, to slide a longitudinal passage or electrode over a guide element directed into tissue. There is no motivation to do so in either reference.

Contrary to the assertion of the Examiner, there is no motivation to combine the teachings of Brucker and Panescu in the absence of Applicant's discovery..

Accordingly, independent claims 17 and 28, and claims 21, 24 and 31 that depend therefrom, are patentable over the teachings of Brucker combined with Panescu. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Brucker in view of Nishtala

Claim 32 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brucker in view of U.S. Patent No. 6,616,678 to Nishtala *et al.* ("Nishtala"). See page 6 of the Office Action. Claim 32 depends from independent claim 28.

The Examiner contends that "Nishtala discloses a dilating element for enlargening [sic] a tract created in an analogous protocol to the Applicant's and Brucker's. The motivation to combine the patents would be to permit an easy and consistent means of creating a patent [sic] tract for passageway of surgical tools such as Brucker's." Page 6 of the Office Action.

However, neither Brucker nor Nishtala describe or suggest a method for thermal ablation of a target volume including perforating and penetrating a living body using a guide element to establish a tract through the body to the target volume and sliding an electrode along and over the guide element directed into the body to position the electrode near the target volume, as recited in independent claim 28. Neither reference provides any motivation to slide an electrode along and over a guide element directed into the body.

Contrary to the assertion of the Examiner, there is no motivation to combine the teachings of Brucker and Nishtala in the absence of Applicant's discovery.

Thus, independent claim 28, and claim 32 that depends therefrom, are patentable over the combination of Brucker with Nishtala. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Obviousness-type Double Patenting

Claims 1-27 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,506,189 ("the '189 patent"). See page 6 of the Office Action. Claims 1, 11, 14 and 17 are independent.

The Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because both the application and the patent disclose a

hollow tubular member with electrodes and fluid conduits." See page 6 of the Office Action. However, nothing in the '189 patent suggests has a device or system for ablating tissue that includes an elongate member defining a longitudinal passage or lumen having a distal opening and a proximal opening dimensioned to pass or slide over a guide element directed into the tissue. The Examiner has not presented a *prima facie* case that, in the absence of Applicant's discovery, a person of skill in the art would be motivated to alter the structure of claims 1-6 of the '189 patent to include a longitudinal passage or lumen having a distal opening and a proximal opening dimensioned to pass or slide over a guide element directed into the tissue. Thus, claims 1-27 are not obvious over claims 1-6 of the '189 patent.

Applicant respectfully requests reconsideration and withdrawal of this rejection.

CONCLUSION

Applicant respectfully requests allowance of the pending claims. Enclosed is a petition for a three month extension of time along with a check for the required fee. Also enclosed is a check for the excess claims fee. Please apply any other charges or credits to deposit account 19-4293.

Respectfully submitted,

Date: _____

3-24-04



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